

REMARKS

The claims pending in the application are claims 1-26, claims 1-10, 12-16, 18-20, 23, and 24 are under consideration and claims 11, 17, 21, 22, 25, and 26 have been withdrawn from further consideration as being drawn to a non-elected invention. In the response no new matter has been added to the application and claims 2, 3, 16, 18, and 20 have been amended. In the response, Applicant has added new claims 27-30.

The Office Action

In the office action, the Examiner objected to the length of the abstract. In the response, the Applicant has amended the length of the abstract to bring it within the length guidelines in MPEP. § 608.01(b). Applicant requests that the ground for objection is withdrawn.

35 U.S.C. § 112, 2nd ¶ Rejection

The Examiner rejected claims 2, 3, 16, 18, and 20 under 35 U.S.C. § 112, 2nd ¶ Rejection as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. The Examiner cited the phrase "variation in said angle" in the above claims as the basis for the rejection. Applicant has amended the above noted claims of the application accordingly, by deleting the cited phrase from each claim. Applicant requests that this ground for rejection of the claims is withdrawn in view of the amendment to the relevant claims.

35 U.S.C. §102 Rejection

The Examiner rejected claims 1-3 and 12 under 35 U.S.C. § 102(b) as being anticipated by Wright (U.S. Patent 4,744,278) The Examiner comments that Wright discloses a device with every structural limitation of the claimed invention.

To anticipate a claim, a single source must contain all of the elements of the claim. See *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379, 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986); *Atlas Powder Co. v. E.I. du Pont De Nemours & Co.*, 750 F.2d 1569, 1574, 224 U.S.P.Q. 409, 411 (Fed. Cir. 1984); *In re Marshall*, 578 F.2d 301, 304, 198 U.S.P.Q. 344, 346 (C.C.P.A. 1978). Missing elements may not be supplied by the

knowledge of one skilled in the art or the disclosure of another reference. See *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 716, 223 U.S.P.Q. 1264, 1271 (Fed. Cir. 1984).

Applicant respectfully requests that the Examiner withdraw the rejection based on Wright for at least the reason that the reference does not disclose each and every element of the claimed invention. First the reference does not disclose a saw chain. Second the reference does not disclose a saw chain having a base member adapted to be pivotally connected to other links of the saw chain. Third, the cutting element does not engage a base member. In Wright the cutting member engages a clevis and not the saw plate. In determining what should be considered a base, Applicant referred to the Webster's New World Dictionary 4th Edition in which the most appropriate definition for a base is "a part of a thing at the bottom acting as support of the underlying structure". Therefore, in Wright the base is the saw plate and not the clevis which engages the cutting member. For the above reasons, Applicant requests that the rejection is withdrawn.

Additionally Applicant added claims 27-30 which are not disclosed in the Wright reference. For the above Applicant states that all pending claims are patentable over the Wright reference.

The Examiner rejected claims 1-3 and 12-14 under 35 U.S.C. § 102(b) as being anticipated by Raetz (U.S. Patent 3,547,167) The Examiner comments that Raetz discloses a device with every structural limitation of the claimed invention.

To anticipate a claim, a single source must contain all of the elements of the claim. See *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379, 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986); *Atlas Powder Co. v. E.I. du Pont De Nemours & Co.*, 750 F.2d 1569, 1574, 224 U.S.P.Q. 409, 411 (Fed. Cir. 1984); *In re Marshall*, 578 F.2d 301, 304, 198 U.S.P.Q. 344, 346 (C.C.P.A. 1978). Missing elements may not be supplied by the knowledge of one skilled in the art or the disclosure of another reference. See *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 716, 223 U.S.P.Q. 1264, 1271 (Fed. Cir. 1984).

Applicant respectfully request that the Examiner withdraw the rejection based on Raetz for at least the reason that Raetz does not disclose each and every element of the independent claim 1. For example, claim 1 includes the element "wherein said first taper

and said second taper extend at an angle ranging from about 0.5° to about 45° relative to a direction of chain travel.” Raetz does not disclose this element. Raetz discloses that the two tapers form an angle of 3° to 5° counter to the direction of travel of the chain. See claim 4 of the Raetz reference.

For the above reasons, the rejection of claim 1 is improper and the Examiner is requested to reconsider and withdraw the rejection to claim 1.

Additionally the Raetz reference does not disclose the “vertically continuous protrusion extending upward from the base member to engage the cutting member” of claim 29. The Raetz reference discloses a protrusion that extends horizontally from the base member and the protrusion is not continuous in the vertical direction from a base member. For the above reason claim 29 is patentable over the Raetz reference.

35 U.S.C. §103 Rejection

The Examiner rejected claims 4-10, 15, 16, 18, 19, 23, and 24 under 35 U.S.C. § 103(a) as being unpatentable over Wright or Raetz in view of Funakubo (U.S. Patent 3,800,633). According to the Examiner Wright and Raetz, each taken separately, disclose almost every structural limitation of the claimed invention as described above, but lack the specific material designations for each of the base member and the cutter member in accordance with the aforementioned claims rejected under 35 U.S.C. § 103(a).

The Examiner continued that with respect to claims 4, 6-10, 15, 18, and 19, it is respectfully submitted that the use of such material on cutting teeth is old and well known in the art. The Examiner alleges that Funakubo includes an example which teaches many of the materials set forth in the above claims and that these materials are used for their known benefits including improved durability and strength characteristics. The Examiner then opines that it would have been obvious to one of ordinary skill in the art to use the subject materials to make the cutters of Wright and Raetz.

As for claims 5 and 10, the Examiner took official notice that such materials are old and well known in the art to provide various benefits and that it would have been obvious to one of ordinary skill in the art to use the subject materials to make the cutters of Wright and Raetz.

In stating the above 103 rejection, Applicant is assuming that the secondary reference is Funakubo (U.S. Patent 3,800,633) for the reason that the reference is not listed in paragraph 10 of the office action, but is subsequently noted in a section of the office action supporting the obviousness rejection. If this is incorrect, Applicant requests that the Examiner, withdraw the office action mailed August 10, 2006 and this response and file another office action, in which the references which make up the grounds for rejection are sufficiently identified and restart the period for response per issuance of the replacement office action.

To establish a *prima facie* case, the PTO must satisfy three requirements. First, the prior art relied upon, coupled with the knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or to combine references. See *Karsten Mfg. Corp. v. Cleveland Gulf Co.*, 242 F.3d 1376, 1385, 58 U.S.P.Q.2d 1286, 1293 (Fed. Cir. 2001) ("In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in the way that would produce the claimed invention."); *C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1352, 48 U.S.P.Q.2d 1225, 1232 (Fed. Cir. 1998) (a showing of a suggestion, teaching, or motivation to combine the prior art references is an "essential evidentiary component of an obviousness holding"). *Northern Telecom v. Datapoint Corp.*, 908 F.2d 931, 934, 15 U.S.P.Q.2d 1321, 1323 (Fed. Cir. 1990) (It is insufficient that the prior art disclosed the components of the patented device, either separately or used in other combinations; there must be some teaching, suggestion, or incentive to make the combination made by the inventor."); *Abbott Laboratories v. Syntron Bioresearch, Inc.*, 334 F.3d 1343, 67 U.S.P.Q.2d 1337 (Fed. Cir.), *reh'g denied*, 2003 U.S. App. LEXIS 17605 (2003) ("Knowledge in the prior art of every element of a patent claim, however, is not of itself sufficient to render claim obvious. The issue is whether substantial evidence supports the judgment (under the clear and convincing evidence standard) that a person having ordinary skill in the art would not have been motivated to replace the [prior art process] with [the process of the invention]."). The teachings or suggestions, as well as the second requirement,

expectation of success, must come from the prior art, not applicant's disclosure. See *In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991).

Second, the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. In other words, a hindsight analysis is not allowed. See *Amgen, Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200, 1209, 18 U.S.P.Q.2d 1016, 1023 (Fed. Cir. 1991) (While the idea of using a monkey gene to probe for a homologous human gene may have been "obvious to try," many pitfalls existed that would have eliminated a reasonable expectation of successfully obtaining the EPO gene.

"Hindsight is not a justifiable basis on which to find that ultimate achievement of a long sought and difficult scientific goal was obvious.").

Lastly, the prior art reference or combination of references must teach or suggest all the limitations of the claims. See *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970) ("All words in a claim must be considered in judging the patentability of that claim against the prior art.").

Applicant respectfully requests that the Examiner withdraw the rejection for the following reasons (1) the mandated suggestion or incentive that would have motivated the skilled artisan to modify a reference or to combine references has not been provided and (2) the combination of references does not teach or suggest all of the elements of the claim.

As for the motivation to combine, the Examiner alleges that Funakubo discloses that the claimed materials are used for known benefits of improved durability and strength characteristics. In reviewing the reference, Funakubo repeatedly discloses that the materials in the reference have been selected for their hardness and flexural strength to survive the welding or brazing process to become an integral part of the saw plate 1 of Funakubo. Applicant respectfully request that the Examiner provide guidance as to what specific properties he is referring to and where those properties may be found in the reference for those properties other than those associated with the ability of the material of tip 5 to withstand the process requirements for tip 5 to become an integral part of base plate 2.

If the properties are not within the reference and the motivation to combine is coming from the Examiner's personal belief as to a person of ordinary skill in the art, Applicants respectfully requests that the Examiner in his next Official Action submit an affidavit detailing as specifically as possible such motivation (see 37 CFR §1.104 (d) (2)).

As for the claimed invention, an aspect of the claimed invention is that the cutting member may releasably engage the base unit. With this in mind Applicant's respectfully refute the Examiner's position that a person of ordinary skill would look to a reference which teaches chemically bonding two (2) materials together for guidance on a suitable cutting edge for a cutting member which is to be releasable from the base member. As for the relevant claims, independent claims 15 and 19 specifically require that the cutting element releasably engages a seat surface of the base member.

With respect to the missing elements, Applicant incorporates herein by reference the above comments regarding the references Wright and Raetz and independent claim 1. As for claims 15, 18, and 19 Wright does not disclose the aforementioned base member pivotally connected to other members of the saw chain. As for claims 16, 18, and 19, both Wright and Raetz do not disclose the claimed angles as discussed above.

Also, there is at least one fundamental difference between the claimed invention and the teachings of Wright. Wright teaches a person to ordinary skill in the art to attach a cutting element to a clevis by using a protrusion extending away from the cutting surface in a direction away from the direction of movement. In Wright, the protrusion appears to extend from a flat back surface of the cutting element. To use the cutting element of Wright in a chain saw blade, it would be heat treated and the heat treatment would create a weak point at the junction between the back surface of the cutting element and the protrusion. In light of the various forces which are applied to a cutting element of a chain saw and the numerous directions which such forces are applied, the junction of the protrusion and back surface of Wright would not hold up as a cutting element for a chain saw. The fact that the cutting element of a chain saw blade sees many more forces and forces from many different directions was a fundamental observation that the Applicant made as part of the research associated with the claimed elements.

In Raetz, it appears that cutting sleeve 9 does not wrap completely around stud 7. Also, as shown in the drawings a space exists between the back of the cutter and the front of stud 7. These gaps will cause the cutting element to move back and be opened up as soon as the cutting element engages the wood. Conversely when the cutter "dolphins" backward it will push the cutter forward. Also the stud 7 of Raetz is not appropriate for cutting wood as described above with respect to the comments regarding claim 1.

Additionally, Applicant hereby requests that the Examiner either withdraw the rejection of claims 5 and 10 or make a showing why the Examiner believes that the elements of claims 5 and 10 are well known in the art. Applicant requests that the Examiner either provide a reference which teaches the claimed element along with the proper *prima facie* showing or provides an Examiner affidavit why the element would be obvious to a person of ordinary skill in the art which includes the proper *prima facie* showing for the rejection. Applicant does not understand the basis why the Examiner rejects claim 4 based on the references, but then concludes that claims 5 and 10 which further define claim 4 can be appropriately rejected based on official notice.

The Examiner does not provide any guidance why claims 23 and 24 are rejected under 35 U.S.C. § 103(a). As such, Applicant requests that the rejection of these two claims is withdrawn for at least the reason that the Examiner has not provided any guidance why the claims are rejected.

For the above reasons, Applicant respectfully states that the claims of the application are patentable over the cited 103 rejection and that the rejection is withdrawn.


CONCLUSION

For the reasons detailed above, it is respectfully submitted all claims remaining in the application (Claims 1-10, 12-16, 18-20, 23, 24 and 27-30) are now in condition for allowance.

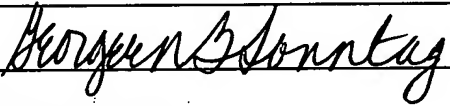
Respectfully submitted,

FAY, SHARPE, FAGAN,
MINNICH & McKEE, LLP

10/23/06
Date



Timothy R. Krogh, Reg. No. 40,688
1100 Superior Avenue, Seventh Floor
Cleveland, OH 44114-2579
216-861-5582

CERTIFICATE OF MAILING OR TRANSMISSION	
I hereby certify that this correspondence (and any item referred to herein as being attached or enclosed) is (are) being	
<input checked="checked" type="checkbox"/>	deposited with the United States Postal Service as First Class Mail, addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date indicated below.
<input type="checkbox"/>	transmitted to the USPTO by facsimile in accordance with 37 CFR 1.18 on the date indicated below.
Express Mail Label No.:	Signature: 
Date: <u>10/23/06</u>	Name: Georgeen B. Sonntag

N:\MND\200002\US\trk0000030V001.doc